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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,509	12/19/2000	Masaki Ito	100794-11514	7520
26304 7590 01/12/2007 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER KANG, PAUL H	
			ART UNIT	PAPER NUMBER
			2144	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/12/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/741,509

Applicant(s)

ITO ET AL.

Examiner

Paul H. Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/19/00.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Examiner Sajid Yussuf is no longer assigned to the present patent application. This application is now assigned to Examiner Paul H. Kang. In examining this patent application, full faith and credit has been given to the search and action of the previous examiner. MPEP § 719.05.

2. In light of the Petition Decision mailed September 28, 2006 granting applicants' petition under 37 CFR 1.137(b), filed July 17, 2006, to revive the instant application, PROSECUTION IS HEREBY REOPENED. A detailed action follows.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Nixon et al, US Patent No. 6,513,060 (hereinafter referred to as Nixon).

5. As per claim 1, Nixon discloses a monitoring unit which monitors each communicability

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state of terminals, each of which is exclusively used for a person, detects a change between a current communicability state of the terminals and a previous communicability state of the terminals, and generates monitoring results in accordance with detecting the change, (See Column 1 Lines 43-67); and

an editing communication unit (i.e., control unit) which edits the monitoring results of the terminals and transmits edited monitoring results on a network, (See Column 3 Lines 41-54) .

6. As per claim(s) 2 Nixon teaches the claimed invention as described in claim(s) 1 above and furthermore discloses the editing communication unit sets to incommunicable state a terminal that has been in incommunicable state for a period of time or longer (i.e., halting service), (See Column 4 Lines 43-50).

7. As per claim(s) 3 Nixon teaches the claimed invention as described in claim(s) 1-2 above and furthermore discloses a server wherein the editing communication unit edits the monitoring results of the terminals in e-mail format and transmits edited monitoring results to the server, (See Column 4 Lines 31-44).

8. As per claim(s) 4 Nixon teaches the claimed invention as described in claim(s) 1-3 above and furthermore discloses a World Wide Web server (i.e., web server) , wherein the communication editing unit edits the monitoring results of the terminals in tagged-text format and provides the edited monitoring results to the World Wide Web server as a file name

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including a date and/or time of day, (See Column 6 Lines 58-67 as Column 7 Lines 1-25) .

9. As per claim(s) 5 Nixon teaches the claimed invention as described in claim(s) 1-4 above and furthermore discloses the server is an FTP (File Transfer protocol) server and the communication editing unit edits the edited monitoring results into table-format data and provides the edited monitoring results to the FTP server as a file name including date and/or time of day, (See Column 5 Lines 50-67 and Column 7 Lines 1-25).

11. As per claim(s) 6 Nixon teaches the claimed invention as described in claim(s) 1-5 above and furthermore discloses billing information corresponding to the communication executed by the terminals is included in the edited monitoring results, (See Column 13 Lines 20-30).

12. As per claim(s) 7 Nixon discloses a monitoring unit which monitors each communicability state of terminals, each of which is exclusively used for a person, and stores the communicability state in the monitoring unit, (See Column 1 Lines 43-67); and an agent reception (i.e., control unit) and transfer unit which, when at least one terminal is in an incommunicable state detected by the monitoring unit, the agent reception and transfer unit receives e-mail instead of a user of a terminal that is in the incommunicable state and transfers the received e-mail to a desired transfer destination; wherein it control the report unit which is in turn in charge of sending e-mails, (See Column 5 Lines 27-40).

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13. As per claim(s) 8 Nixon teaches the claimed invention as described in claim(s) 7 above and furthermore discloses the agent reception and transfer unit which receives e-mail instead of the user, including one or more prescribed characters in a title of the received e-mail, and transfers the received e-mail to the desired transfer destination, (See Column 7 Lines 1-25).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nixon et al. (US Patent No. 6,513,060 and Nixon hereinafter) in view of Fuisz et al., US Patent No. 6,389,455 (hereinafter referred to as Fuisz).

16. As per claim 9, Nixon discloses the claimed invention substantially as claimed. However, Nixon does not explicitly teach the prescribed characters are included in the title of the e-mail, the agent reception and transfer unit sets the e-mail to be in unread state.

In the same field of endeavor, Fuisz teaches if the prescribed characters are included in the title of the e-mail, the agent reception and transfer unit sets the e-mail to be in unread state, (See Fuisz Column 4 Lines 57-67 and Column 5 Lines 1-10).

Therefore it would have been obvious to a person having ordinary skill in the art at the

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time of Applicant's invention to modify the teaching of Nixon with the teachings of Fuisz to include the prescribed characters are included in the title of the e-mail, the agent reception and transfer unit sets the e-mail to be in unread state with the motivation to provide for a User sending an e-mail from a secondary account (e.g. corporate intranet account etc), the possibility exists that the recipient will respond utilizing the "reply" command. To ensure that such "replies" are routed through the bounce system, users may address outgoing e-mail to a special forwarding address and embed the ultimate address in a non-address portion of the e-mail (e.g. the re: line, to line, from line, cc line, bcc line, etc.).

Upon receipt of the e-mail the bounce system (i) identifies and strips the embedded address from the e-mail and (ii) identifies the primary account of the user. The bounce system then forwards the e-mail content to the ultimate addressee, in the form of an e-mail from the user's primary account. If the recipient chooses to "reply" to this e-mail, such response will be routed through the bounce system, (See Fuisz Column 2 Lines 28-43).

18. As per claim(s) 10 Nixon discloses the claimed invention as described above.

However, Nixon does not explicitly teach an e-mail address of the transmission origin of the e-mail before the e-mail is received agrees with the e-mail address used by the agent reception and transfer unit, the agent reception and transfer unit sets the e-mail to be in unread state.

Fuisz teaches an e-mail address of the transmission origin of the e-mail before the e-mail is received agrees with the e-mail address used by the agent reception and transfer unit, the agent reception and transfer unit sets the e-mail to be in unread state, (See Fuisz Column 5 Lines 60-67 86 Column 6 Lines 1-22).

Therefore it would have been obvious to a person having ordinary skill in the art at the time of Applicant's invention to modify the teaching of Nixon with the teachings of Fuisz to include an e-mail address of the transmission origin of the e-mail before the e-mail is received agrees with the e-mail address used by the agent reception and transfer unit, the agent reception and transfer unit sets the e-mail to be in unread state with the motivation to provide for a User sending an e-mail from a secondary account (e.g. corporate intranet account etc), the possibility exists that the recipient will respond utilizing the "reply" command. To ensure that such "replies" are routed through the bounce system, users may address outgoing e-mail to a special forwarding address and embed the ultimate address in a non-address portion of the e-mail (e.g. the re: line, to line, from line, cc line, bcc line, etc.). Upon receipt of the e-mail the bounce system (i) identifies and strips the embedded address from the e-mail and (ii) identifies the primary account of the user. The bounce system then forwards the e-mail content to the ultimate addressee, in the form of an e-mail from the user's primary account. If the recipient chooses to "reply" to this e-mail, such response will be routed through the bounce system, (See Fuisz Column 2 Lines 28-43).

### ***Response to Arguments***

10. Applicant's arguments filed August 15, 2006 have been fully considered but they are not persuasive. The applicants argued in substance that the prior art of record fails to teach monitoring terminals, and instead teaches monitoring web servers. "In addition applicant's claim 3 recites sending to the server, whereas Nixon describes contacting a person. Nixon discloses, for example, at column 5, lines 54-56, 'the host units are preferably run on any pingable computer, including but not limited to Unix hosts, web servers, DNS servers, mail servers, FTP servers,



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news servers, and the like.' In the specification of Nixon, pingable computers are disclosed as servers."

The examiner respectfully disagrees. Firstly, in response to applicant's argument that "terminals, each of which is exclusively used for a person" is patentably distinct from the "computers" of Nixon, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, exclusive use by a person does not structurally alter the computer in question.

Secondly, applicants argue limitations which are not essential to the scope of the prior art. The definiteness of the language employed must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Insofar, the claims have been given the broadest reasonable interpretation consistent with the specification and the prior art, since the applicant may then amend his claims, the thought being to reduce the possibility that after a patent is granted the claims may be interpreted as giving broader coverage than is justified. Therefore, applicant's arguments regarding "terminals, each of which is exclusively used for a person" are not given weight as to the patentability of the claimed subject matter.

***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
**PAUL H. KANG**  
**PRIMARY PATENT EXAMINER**